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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/633,926 | 08/04/2003 | Gregory M. Chapman | 2986.4US (96-0789.04/US) | 4960 |

24247 7590 05/19/2004

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| EXAMINER | |
|---|---|
| HARAN, JOHN T | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1733 | |

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/633,926 | CHAPMAN, GREGORY M. | |
| | Examiner | Art Unit | |
| | John T. Haran | 1733 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *04 August 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 March 2004 and 04 August 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *8/4/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement (IDS) submitted on 8/4/03 has been considered by the examiner.

### *Drawings*

2. The replacement sheets of drawings for Figures 3 and 16 were received on 3/4/04. These drawings are accepted.

### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-27 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20, 26, 28, 29, 30, and 34-36 of U.S. Patent No. 6,607,019. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference between claims 1 and 18 of the application and corresponding claims 1 and 18 of the patent is that the operation the leadframes and first and second adhesive materials are supplied in a

continuous manner and the frames are indexed in a continuous manner. It is clear from the Figures and specification of the patent that the system is capable of operating in a continuous manner and it would have been obvious to do so because such is more efficient. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the system to be capable of operating in a continuous manner in the system of U.S. Patent 6,607,019.

5. Claims 1-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4-223, 29, 31, 32, 33, and 37-39 of U.S. Patent No. 6,267,167. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 18 of the application and corresponding claims 6 (incorporating limitations of claim 1-3) and 21 of the patent is that the operation the leadframes and first and second adhesive materials are supplied in a continuous manner and the frames are indexed in a continuous manner. It is clear from the Figures and specification of the patent that the system is capable of operating in a continuous manner and it would have been obvious to do so because such is more efficient. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the system to be capable of operating in a continuous manner in the system of U.S. Patent 6,267,167.

Claim 1 of the application also requires that the leadframes have removable portions for engagement by a portion of the application apparatus, however the patent discloses such in that the leadframes have a removable edge for mating the drive

perforations of the indexing apparatus (See claim 27 of patent). It would have been obvious to one of ordinary skill in the art at the time the invention was made for the leadframes to have removable portions for engagement by a portion of the application apparatus in the system of U.S. Patent 6,267,167.

Claim 18 of the application also requires that indexing apparatus urge the plurality of leadframes in a desired position for application of adhesively coated material, however one skilled in the art would have readily appreciated that the indexing apparatus would necessarily need to index each leadframe into a desired position for the application of the adhesive material in order for it to be applied to the leadframes. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the index apparatus capable of urging the leadframes into position for application of the adhesively coated material in the system of U.S. Patent 6,267,167.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John T. Haran** whose telephone number is **(571) 272-1217**. The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John T. Haran
Examiner
Art Unit 1733